REMARKS

Applicants thank the Patent Office for initialing the references listed on the PTO/SB/08 A & B form submitted with the Information Disclosure Statement filed on January 14, 2005, thereby confirming that the listed references have been considered.

Claims 1-7, 9 and 11-20 have been examined on their merits.

Since there are no pending 35 U.S.C. §§ 102, 103 and/or 112 rejections pending against claims 11-16, Applicant requests that these claims be indicated as allowed in the next communication from the Patent Office.

Applicants herein amend claim 20 to correct an informality.

Claims 1-7, 9 and 11-20 are all the claims presently pending in the application.

1. Claims 1-7, 9 and 17-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boivie (U.S. Patent No. 6,502,140). Applicants traverse the § 103(a) rejection of claims 1-7, 9 and 17-20 for at least the reasons discussed below.

The Patent Office acknowledges that the difference between independent claims 1 and 7 and Boivie lies in the type of addressing used. The Patent Office further acknowledges that the final destination addresses of independent claims 1 and 7 do not include references to the intermediate node(s), while Boivie's addressing scheme does reference intermediate node(s). The Patent Office characterizes Applicants' inventive address compression technique as obvious to one of ordinary skill in the art because it would have the benefit of traffic reduction.

The characterization of certain claim limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. It is incumbent upon the Patent Office to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *In re Lalu*, 747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984). Furthermore, an Patent Office may not rely on official notice, judicial notice or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *Ex parte Cady*, 148 U.S.P.Q. 162 (Bd. of App. 1965). Here, one of the points of novelty of the present invention is at least the exclusion of intermediate addresses from the compound destination address consisting only of compressed final destination addresses. The Patent Office has not cited, nor has the Applicant identified, any prior art which suggests or teaches this, or any other novel aspects of the present invention found in claims 1-7, 9 and 17-20.

Furthermore, even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d at 1316-1317 (*citing B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996)); *see also*, *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (B. Pat. App. & Inter. 1985)) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been

obvious in light of the teachings of the references."). Here, the only evidence that is proffered by the Patent Office is that it would have been obvious to modify Boivie. As discussed in several previous submissions to the Patent Office, a compound address created under Boivie's disclosed method would be stymied in its transmission if, for some reason, intermediate addresses R1 or R2 were unreachable. Boivie discloses that if a routing error occurs, then the sending node (node A in Figure 1 of Boivie) is informed and the node A has to readjust its multicast tree. *See* col. 4, line 64 to col. 5, line 14 of Boivie. In other words, the intermediate addresses R1 and R2 are a necessary component of Boivie's addressing scheme. Applicants have devised a novel method of overcoming the above-discussed shortcomings of Boivie, and the Patent Office has not come forward with any additional prior art and/or cogent reasoning (other than a bald assertion) as to why it would be obvious to one of ordinary skill to modify Boivie.

Finally, the burden is on the Patent Office to demonstrate using only objective evidence or suggestion from the applied prior art, that one of ordinary skill would have been lead to the claimed invention as a whole without recourse to Applicants' disclosure. *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 U.S.P.Q.2d 1443, 1446-47 (Fed.Cir.1992); *In re Fine* 837 F.2d 1071, 1074-75, 5 U.S.P.Q.2d 1596, 1598-1600 (Fed.Cir.1988). As a matter of law then, it is the burden of the Patent Office to demonstrate that the prior art, and not Applicants' disclosure, would lead the hypothetical artisan to the claimed invention as a whole. Here, the only mention of the compound destination address consisting only of compressed final destination addresses is in the Applicants' disclosure. The Patent Office has not identified any text and/drawings in the

disclosure of Boivie that would lead one of ordinary skill in the art to the invention recited in independent claims 1 and 7.

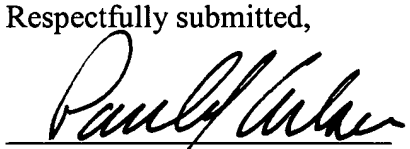
Based on the foregoing reasons, Applicants submit that independent claim 1 is allowable over Boivie, and further submit that claims 2-6, 9, 17, 19 and 20 are allowable as well, at least by virtue of their dependency from claim 1. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 1-6, 9, 17, 19 and 20.

With respect to independent claim 7, Applicants submit that independent claim 7 is allowable for at least reasons analogous to those discussed above with respect to claim 1. Applicants further submit that claim 18 is allowable as well, at least by virtue of its dependency from claim 7. Applicants respectfully request that the Patent Office reconsider and withdraw the § 103(a) rejection of claims 7 and 18.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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AMENDMENTS TO THE DRAWINGS

The Patent Office objects to the Drawings under 37 C.F.R. § 1.83(a). Applicants herein add one new sheet of drawings to illustrate an exemplary embodiment of the compression device of instant application. No new matter has been added. Applicants also note that U.S. Patent No. 6,502,140 to Boivie illustrates nothing more than a computer for performing its multicasting address derivation. Furthermore, the originally filed claims of the instant application provide sufficient support for the new Drawing (*e.g.*, original claim 1: means for detecting a common prefix, means for generating a sequence of suffixes and means to add suffix sequence to the detected common prefix). Although Applicants believe that one of ordinary skill in the art could make and use the compression device recited in the claims of the instant application without undue experimentation, Applicants are submitting an additional Drawing sheet in order to advance the prosecution of the instant application.

Attachment: One (1) New Sheet